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**PATENT APPLICATION**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re application of

ELLUL, MARIA D., et al.

Appln. No.: 08/780,507

Group Art Unit: 1713

Confirmation No.: Unknown

Examiner: F. ZITOMER

Filed: January 08, 1997

For: TRANSLUCENT THERMOPLASTIC ELASTOMERS

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TC 1700

**SUBMISSION OF APPELLANT'S BRIEF ON APPEAL**

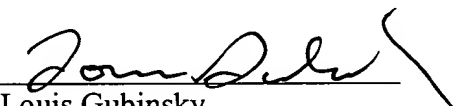
Commissioner for Patents  
Washington, D.C. 20231

Sir:

Submitted herewith please find an original and two copies of Appellant's Brief on Appeal. A check for the statutory fee of \$310.00 is attached. Authorization is also given to charge or credit any difference or overpayment to Deposit Account No. 19-4880. A duplicate copy of this paper is attached.

Respectfully submitted,

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Date: July 6, 2001

PATENT APPLICATION

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**APPELLANTS' BRIEF ON APPEAL UNDER 37 C.F.R. § 1.192**

Commissioner for Patents  
Washington, D.C. 20231

Sir:

In accordance with the provisions of 37 C.F.R. § 1.192, Appellant submits the following:

**I. REAL PARTY IN INTEREST**

The real party in interest is ADVANCED ELASTOMER SYSTEMS of Akron, Ohio.

**II. RELATED APPEALS AND INTERFERENCES**

There are no related appeals and interferences which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**III. STATUS OF CLAIMS**

**A. Claims Appealed**

Appellant carries this Appeal forward with respect to claims 17-19.

**B. Status of all claims**

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Claims 6-9 were canceled in an Amendment filed November 21, 2000. Claims 1-5 and 10-16 were requested to be canceled in a 37 C.F.R. § 1.116 Amendment filed April 22, 2001. In Advisory Action of June 2, 2001, the Examiner indicates that the Request for Reconsideration filed April 22, 2001 does not place the application in condition for allowance, and indicates that the claims remaining rejected are claims 1-5 and 10-19. It is believed this statement of pending claims was incorrect in the Advisory Action, since Appellants requested claims 1-5 and 10-16 be canceled. In any event, as it is indicated herein, Appellants carry this appeal forward with respect to only claims 17-19.

#### **IV. STATUS OF AMENDMENTS**

A 37 C.F.R. § 1.116 Amendment which only canceled claims was filed April 22, 2001. According to the Advisory Action received subsequent thereto, the claims requested to be canceled are still pending. In any event, as noted herein, Appellants carry this appeal forward only with respect to claims 17-19.

#### **V. SUMMARY OF THE INVENTION**

The claimed invention is directed to thermoplastic elastomer compositions having improved optical translucence. (page 3, lines 5-6). The improvement in optical translucence is provided by incorporating syndiotactic polypropylene homopolymer into the elastomer composition. (page 3, lines 6-7)

Each of claims 17, 18, and 19 is directed to the compositions of Example 1 of the present application as set forth at page 8, line 9 through page 9, line 14, plus the descriptions of the three EPDM materials "A" "F" "G", plus description of syndiotactic polypropylene "1" as set forth at page 13, lines 1-3, 11, 16 and 17..

## **VI. ISSUES.**

The essential issue in the present Appeal is whether Appellants are entitled to the benefit for the claims on appeal of the filing dates of their parent applications, including their first filed application U.S. Serial No. 08/206,984, filed March 4, 1994. The reason why this is the central issue involved is that all claims stand rejected under 35 U.S.C. § 102(e) as being anticipated by Masuda, et al. U.S. Patent 5,525,675, filed March 23, 1994. Appellants first filed U.S. application was filed on March 4, 1994, thus antedating Masuda et al if Appellants are entitled to their March 4, 1994 filing date.

## **VII. GROUPING OF CLAIMS**

All claims stand or fall together .

## **VIII. ARGUMENTS**

All claims stand rejected under 35 U.S.C. § 102(e) as being anticipated by Masuda et al., U.S Patent 5,525,675, granted June 11, 1996 and filed March 23, 1994.

Appellants do not question that Masuda et al anticipates or at least renders obvious Appellants' claims. Appellants have requested an interference with Masuda et al.

Appellants' present application is a continuation-in-part application of copending Serial No. 08/619,135, filed March 20, 1996, in turn a continuation of U.S. Serial No. 08/390,906, filed February 16, 1995, in turn a continuation of U.S. Serial No. 08/206,984, filed March 4, 1994. All parent applications have been abandoned.

Appellants' claims 17, 18, and 19 are directed to compositions set forth in Example 1, which begins at page 8, line 9 of the present application. All the compositions of Example 1 contain 76 wt% EPDM rubber and 24 wt% polypropylene. As set forth in Table 1 at the top of

page 9, three syndiotactic polypropylenes were used, along with three EPDM polymers, based on content of ethylene. One of the syndiotactic polypropylenes, that is syndiotactic propylene "1" was used with each of the three EPDM polymers.

Claim 17 is directed to a composition where syndiotactic polypropylene "1" is used with EPDM "A"; claim 18 is directed to the composition where syndiotactic polypropylene "1" is used with EPDM "F" and claim 19 is directed to the composition where syndiotactic polypropylene "1" is used with EPDM "G".

In Table V, which begin at the top of page 13, and corresponds to Table V found at page 12 of Appellants' parent applications, polypropylene "1" is defined. In this regard, in Appellants' parent applications, polypropylene "1" is defined as "Syndiotactic homopolymer [grade G49M, Hoechst AG]". In the application on appeal, polypropylene "1" is defined as "syndiotactic homopolymer [grade G49M, Hoechst AG] having a syndiotactic pentad fraction of 0.86". Thus, the additional information inserted into the present application as relevant to claims 17, 18, and 19, is that the polypropylene used as the syndiotactic homopolymer has a syndiotactic pentad fraction of 0.86. The syndiotactic pentad fraction of 0.86 is present in each of claims 17, 18, and 19.

In summary, each of claims 17, 18 and 19 is directed to a specific compositional formulation of Example 1 of the present application which includes syndiotactic polypropylene "1". See Example 1 on page 8 and Table I on page 9 of the present application. The Board is respectfully requested to note that the ratio of components in Example 1 is 24 wt % of the polypropylene and 76 wt % of the EPDM rubber, plus 0.39 parts per weight of the specific  $\alpha$ - $\alpha'$  bis(t-butylperoxy)-di-isopropylbenzene curative, as set forth in claims 17-19. Each of claims 17, 18, and 19 is based on the use of syndiotactic polypropylene "1" plus where the EPDM has an

ethylene content of 48% (EPDM "A" - claim 17), an ethylene content of 74% (EPDM "F" - claim 18) or an ethylene content of 77% (EPDM "G" - claim 19). As set forth at page 13, lines 1-2 beneath the heading "Table V", Polypropylene "1" has a syndiotactic pentad fraction of 0.86, also set forth in each of claims 17, 18, and 19.

From the above, each of claims 17, 18, and 19 is directed to a specific formulation of Example 1 of the present application, in which syndiotactic polypropylene "1" is employed with one of the three specific EPDM copolymers set forth in Table I, at page 9 of the application as filed.

Example 1 is set forth in each of Appellants' parent applications. In the parent applications, the syndiotactic pentad fraction of polypropylene "1" was not disclosed. However, the specific grade or source of syndiotactic polypropylene "1" was disclosed, which is set forth at the top of page 13, as grade G49M, from Hoechst AG. This material has a syndiotactic pentad fraction of 0.86, as now specified. Thus, the additional information added to the present application is with respect to an inherent characteristic of the syndiotactic polypropylene "1" used in Example 1 of the present application, which example is found in each of Appellants' parent applications.

In the final rejection, claims 1-5 and 10-19 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Masuda et al.

In the Final Office Action, paragraph bridging pages 2 and 3, the Examiner submits that the limitations relating to syndiotactic pentad fraction of the instant propylene homopolymers are neither disclosed nor suggested in the parent applications. But, certainly the Board must acknowledge that the specific syndiotactic polypropylenes used in Appellant's examples do

inherently have a certain syndiotactic pentad fraction. Those values are very specific syndiotactic pentad fraction values and were possessed by the syndiotactic polypropylenes as originally used in the Examples. Appellants at this time are claiming 3 of the specific formulations found throughout Appellants' chain of parent applications, and nothing more. Clearly, Appellants are entitled to claim specific formulations set forth in their application and in so doing can also set forth in such claims inherent features of those specific formulations. Appellants have done nothing more at this time.

Once it is accepted that Appellants are claiming three specific compositional formulations, which have existed in their chain of applications beginning with their first filed application, Masuda is antedated.

Concerning the law on inherency, Appellants cite for the Board's consideration the cases of Kennecott Corp. V. Kyocera International Inc., 5 USPQ2d 1194 (Fed Cir. 1987) and In re Nathan, 140 USPQ 601 (CCPA 1964).

In Kennecott, the issue was whether the claims of the '299 application, which specifically recited the microstructure of the claimed sintered ceramic body (a predominately equiaxed microstructure), were entitled to the benefit of the earlier '954 application based on inherency in the structure produced in the '954 application.

The only written description in the '299 application that was not present in the original '954 disclosure was the description and pictures of the products' microstructure. It was admitted that the products of Examples 1-30 did have the equiaxed microstructure, and that one skilled in the art could have readily determined the microstructure of the product.

The court decided, with approval of earlier law, that the expressed description of an inherent property was not “new matter”, and could be added to the specification with effect as of the original filing date. The court concluded at page 1198, that “The disclosure in a subsequent patent application of an inherent property of a product does not deprive that product of the benefit of an earlier filing date. Nor does the inclusion of a description of that property in later-filed claims change this reasonable result”

The court cited with approval from its predecessor court, In re Nathan at 140 USPQ 601, 604 (CCPA 1964), where the court held that a later-added limitation to the claims of the compound’s alpha orientation was “an inherent characteristic” of the claimed subject matter, and reversed a new matter rejection. The Nathan court explained that a subsequent clarification of or change in the original disclosure does not necessarily make that original disclosure fatally defective.” *Id* at 603.

From Kennecott and Nathan, setting forth in specific compositional formulation claims 17, 18, and 19 the syndiotactic pentad fraction of the polypropylene used in those compositions does not amount to new matter, nor affect Appellants’ benefit of Appellants’ first filed application. In view of the above, Appellants submit that claims 17, 18 and 19 are allowable.

The present Brief on Appeal is being filed in triplicate. Unless a check is submitted herewith for the fee required under 37 C.F.R. §1.192(a) and 1.17(c), please charge said fee to Deposit Account No. 19-4880.



Appellant hereby petitions for any extension of time which may be required to maintain the pendency of this case, and any required fee for such extension is to be charged to Deposit Account No. 19-4880.

Respectfully submitted,



Louis Gubinsky  
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Date: July 6, 2001

## IX APPENDIX

The claims on appeal are as follows:

17. A composition for preparing a thermoplastic elastomer, which comprises (A) 24 wt.% of propylene homopolymer principally containing propylene units of exactly alternating configuration and having a syndiotactic pentad fraction of 0.86 and (B) 76 wt.% of an ethylene-propylene-diene copolymer containing 48 % ethylene content, and 0.39 parts per 100 based on the sum of (A) and (B) of  $\alpha$ - $\alpha^1$ -bis (t-butyl peroxy) diisopropyl benzene.

18. A composition for preparing a thermoplastic elastomer, which comprises (A) 24 wt.% of propylene homopolymer principally containing propylene units of exactly alternating configuration and having a syndiotactic pentad fraction of 0.86 and (B) 76 wt.% of an ethylene-propylene-diene copolymer containing 74 % ethylene content, and 0.39 parts per 100 based on the sum of (A) and (B) of  $\alpha$ - $\alpha^1$ -bis (t-butyl peroxy) diisopropyl benzene.

19. A composition for preparing a thermoplastic elastomer, which comprises (A) 24 wt.% of propylene homopolymer principally containing propylene units of exactly alternating configuration and having a syndiotactic pentad fraction of 0.86 and (B) 76 wt.% of an ethylene-propylene-diene copolymer containing 77 % ethylene content, and 0.39 parts per 100 based on the sum of (A) and (B) of  $\alpha$ - $\alpha^1$ -bis (t-butyl peroxy) diisopropyl benzene.